

## **REMARKS**

Claims 8-68 are pending. Claims 8-12, 14-18, 20, 21, 26-30, 32, 33, 37, 39-41, 43, 44, 48, and 50-52 have been amended. Claims 54-68 are new, support for which may be found throughout the specification and drawings as filed. Consideration of the following remarks is respectfully requested.

### **Response to Arguments**

For at least the reasons described below, the Applicant respectfully submits that the Office's response to arguments is traversed.

### **§102(b) Claim Rejections**

Claims 33, 39-44, and 50-53 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,796,816 to Utsumi (hereinafter "Utsumi '816"), which is different than the reference U.S. Patent No. 5,636,267 to Utsumi (hereinafter "Utsumi '267") which was previously asserted and is still asserted below in combination in a 103 rejection. The Applicant respectfully traverses these rejections and reserves the right to challenge use of both Utsumi '816 and '267 as references at a later time.

**Utsumi '816**, like Utsumi '267, describes a cleaning system for a telephone number list. In Utsumi '816, a "telephone number list to be cleaned is stored in a floppy disk in a predetermined format for preparation of cleaning. The floppy disk is then inserted in the floppy disk drive 5. A cleaning command is provided with

the personal computer 1 via the keyboard 7 by indicating a file name of the telephone number list to be cleaned. The CPU 2 retrieves the indicated list correspondent to the indicated file name to store it memory 3. Subsequently, the cleaning process shown in the flow chart in FIG. 2 is started.” See *Utsumi* ‘816, Col. 2, Lines 56-64. Thus, **a single cleaning command** (the designated list name) is given to “clean” an entire list of telephone numbers in *Utsumi* ‘816, much like the single cleaning command given in *Utsumi* ‘267. Indeed, the Examiner seems to admit as much at page 2 of the Office Action, the “‘single’ command initiates a clean up of a list (list is containing [sic] more than 1 phone number) and therefore reads on ‘dialing at least two of telephone numbers.’” See *Office Action, Page 2*. It is respectfully submitted that the Examiner has misinterpreted the features of the below claims in relation to *Utsumi*.

**Claim 33** recites one or more tangible computer-readable media comprising instructions that are executable by a communications device to:

- initiate dialing of a plurality of phone numbers included in a list stored by the communications device sequentially such that the dialing of at least two of the plurality of phone numbers is initiated by a respective command, sequentially; and
- return to one or more of the plurality of phone numbers that are unanswered.

The Examiner, in rejecting this claim, references Claim 1, Col. 10 line 27-32 of Utsumi '816 to reject the above features, the entirety of which is reproduced as follows:

**1. A cleaning system for a telephone number list including a computer such as a personal computer, comprising the following elements of:**

**being connected with an ISDN to process circuit-switched call control procedures defined in the ITU-T recommendation Q.931 as a calling terminal;**

**retrieving a telephone number sequentially from a telephone number list to be cleaned as a called party number to send a SETUP message including an unrestricted or a restricted digital information in a bearer capability information element to the network;**

**sending a DISCONNECT message to the network immediately to perform a clear sequence and determining the called party number in the SETUP message effective when the network receives the SETUP message sent and transfers an ALERTING or CONNECT message;**

**performing a clear sequence immediately and obtaining a cause in an information element of the DISCONNECT message from the network to determine the called party number in the SETUP message either effective or null according to the cause when the network does not receive the SETUP message sent and transfers a DISCONNECT message; and**

**generating a new telephone number list, which includes the telephone numbers determined effective and the telephone numbers determined null, separately.**

As shown in the above referenced section, however, although the claim of Utsumi '816 mentions "retrieving a telephone number sequentially from a telephone number list" this claim does not disclose how this process is initiated.

The **only** mention in Utsumi '816 regarding how to initiate the process discloses that "Cleaning command is provided with the personal computer 1 via the keyboard 7 by indicating a file name of the telephone number list to be cleaned." See *Utsumi '816, Col. 2, Lines 59-61*. Utsumi '816 then describes that the cleaning process in Fig. 2 is started. A thorough examination of Fig. 2 reveals that the **single cleaning command is not repeated** and is effective to "clean" the entire list of telephone numbers. Thus, Utsumi '816 does not disclose "dialing of at least two of the plurality of telephone numbers is initiated by **a respective command, sequentially**" as recited in claim 33.

As the Examiner is likely aware, a claim is anticipated **only** if each and every element as set forth in the claim is found, either expressly or inherently in a single prior art reference. Moreover, the **identical** invention must be shown in as complete detail as is contained in the claim. See *MPEP § 2131*. For at least the reasons described above, the Office has failed to show that Utsumi '816 discloses each and every element of claim 33. Further, because the cleaning process described in Utsumi '816 is initiated by a **single cleaning command** (which is not repeated as admitted by the Examiner) and because claim 33 recites that "dialing of at least two of the plurality of phone numbers is initiated by **a respective command, sequentially**", Utsumi '816 fails to disclose the **identical invention** recited in claim 33, as required for a *prima facie* § 102 rejection.

Withdrawal of the rejection is respectfully requested.

**Claims 34-43** depend either directly or indirectly from claim 33 and the comments directed above to claim 33 apply equally to claims 34-43. These claims also recite additional features which, in combination with those recited in claim 33, are neither shown nor suggested in the references of record, either singly or in combination with one another. Withdrawal of the rejection is respectfully requested.

**Claim 44** recites a communications device comprising a processor and memory having instructions that are executable on the processor to form a list having a plurality of phone numbers of unanswered calls of the communications device and provide a feature to sequentially initiate dialing of the plurality of phone numbers included in the list such that the dialing of at least two of the plurality of phone numbers is initiated by a respective command, sequentially.

As described above, Utsumi '816 (like Utsumi '267) describes a system in which a single command is given to clean an entire list of telephone numbers and thus a plurality of telephone numbers are cleaned in response to a single command. However, as stated above claim 44 (like claim 33) recites "the dialing of at least two of the plurality of phone numbers is initiated by *a respective command, sequentially.*" (emphasis added) Thus, the automated system of Utsumi '816 in which the entire list is "cleaned" in response to a single command differs from the features recited in these claims. Withdrawal of the rejection is respectfully requested.

**Claims 45-53** depend either directly or indirectly from claim 44 and the comments directed above to claim 44 apply equally to claims 45-53. These claims also recite additional features which, in combination with those recited in claim 44, are neither shown nor suggested in the references of record, either singly or in combination with one another. Withdrawal of the rejection is respectfully requested.

### **§103 Claim Rejections**

Claims 8, 14-20, 33, 39-44, and 50-53 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,636,267 to Utsumi (hereinafter "Utsumi '267") in view of U.S. Patent No. 5,796,816 to Utsumi (hereinafter "Utsumi '816"). The Applicant respectfully disagrees and reserves the right to challenge use of both asserted documents as a reference at a later time.

**It is respectfully submitted that the Examiner meant to reject claims 8 and 14-20 instead of 8, 14-20, 33, 39-44, and 50-53 as the rejection does not address claims 33, 39-44, and 50-53.**

As recited above, both **Utsumi '267** and **Utsumi '816** describe a cleaning system for a telephone number list. In Utsumi '267, a "floppy disk containing the telephone number list is set in the floppy disk drive 4 and a cleaning command is given by designating a list name through a keyboard 7." *Utsumi '267, Col. 5, Lines 6-10.*

Likewise, in **Utsumi '816**, a “telephone number list to be cleaned is stored in a floppy disk in a predetermined format for preparation of cleaning. The floppy disk is then inserted in the floppy disk drive 5. Cleaning command is provided with the personal computer 1 via the keyboard 7 by indicating a file name of the telephone number list to be cleaned. The CPU 2 retrieves the indicated list correspondent to the indicated file name to store it memory 3. Subsequently, the cleaning process shown in the flow chart in FIG. 2 is started.” See *Utsumi '816*, Col. 2, Lines 56-64. Thus, a single cleaning command (the designated list name) is given to “clean” an entire list of telephone numbers in both Utsumi '267 and Utsumi '816. Indeed, the Examiner seems to admit as much at page 2 of the Office Action, the “‘single’ command initiates a clean up of a list (list is containing [sic] more than 1 phone number) and therefore reads on ‘dialing at least two of telephone numbers.’” See *Office Action*, Page 2. Accordingly, it is respectfully submitted that the Examiner has misinterpreted the features of the below claims.

**Claim 8** has been amended and recites a method comprising:

- sequentially initiating a first call and a second call by dialing a first phone number and a second phone number, respectively, in response to sequentially receiving a first command and a second command, respectively, wherein the first phone number and the second phone number are sequentially included in a stored list; and

- deleting the first phone number and the second phone number from the list in response to a completion of the first call and the second call, respectively.

It is respectfully submitted that Utsumi '267 and '816, alone or in combination, do not teach or suggest these features.

As described above, both Utsumi '267 and '816 (alone and in combination) describe a system in which a single command is given to clean an entire list of telephone numbers and thus a plurality of telephone numbers are cleaned in response to **a single cleaning command**. Utsumi '816 is illustrative to show how the “cleaning” process is initiated. Utsumi '816 discloses that “Cleaning command is provided with the personal computer 1 via the keyboard 7 by indicating a file name of the telephone number list to be cleaned.” See *Utsumi '816, Col. 2, Lines 59-61*. Utsumi '816 then describes that the cleaning process in Fig. 2 is started. A thorough examination of Fig. 2 reveals that the **single cleaning command is not repeated** and is effective to “clean” the entire list of telephone numbers.

However, Claim 8 recites “sequentially initiating a first call and a second call by dialing a first phone number and a second phone number, respectively, in response to sequentially receiving a first command and a second command” and thus differs from the automated system of Utsumi '267 and '816 in which the entire list is “cleaned” in response to **the single command**. Indeed, use of more than a single command runs against the expressed purpose of Utsumi '267 for the



automatic rewriting and updating of the telephone number list. *See Col. 8, Lines 16-42.* The Examiner correctly admits to this in the Office Action.

The Examiner, however, references Claim 1, Col. 10 line 37-43 of Utsumi '816 to correct this defect, the entirety of which is reproduced again as follows for the sake of convenience:

**1. A cleaning system for a telephone number list including a computer such as a personal computer, comprising the following elements of:**

**being connected with an ISDN to process circuit-switched call control procedures defined in the ITU-T recommendation Q.931 as a calling terminal;**

**retrieving a telephone number sequentially from a telephone number list to be cleaned as a called party number to send a SETUP message including an unrestricted or a restricted digital information in a bearer capability information element to the network;**

**sending a DISCONNECT message to the network immediately to perform a clear sequence and determining the called party number in the SETUP message effective when the network receives the SETUP message sent and transfers an ALERTING or CONNECT message;**

**performing a clear sequence immediately and obtaining a cause in an information element of the DISCONNECT message from the network to determine the called party number in the SETUP message either effective or null according to the cause when the network does not receive the SETUP message sent and transfers a DISCONNECT message; and**

**generating a new telephone number list, which includes the telephone numbers determined effective and the telephone numbers determined null, separately.**

As shown, the above referenced section completely fails to mention how the recited “retrieving a telephone number” is initiated. As discussed above, Utsumi ‘816 describes that the “cleaning” process is initiated by *a single cleaning command* that is not repeated, and not that “sequentially initiating a first call and a second call by dialing a first phone number and a second phone number, respectively, in response to sequentially receiving a first command and a second command” as recited in claim 8.

Therefore, it is respectfully submitted that Utsumi ‘816 adds nothing new to Utsumi ‘267, alone or in combination. Further, as admitted by the Examiner Utsumi ‘267 does not teach or suggest this feature. Withdrawal of the rejection is respectfully requested.

**Claims 9-20** depend either directly or indirectly from claim 8 and the comments directed above to claim 8 apply equally to claims 9-20. These claims also recite additional features which, in combination with those recited in claim 8, are neither shown nor suggested in the references of record, either singly or in combination with one another. Withdrawal of the rejection is respectfully requested.

**Claim 33** recites one or more tangible computer-readable media comprising instructions that are executable by a communications device to:

- initiate dialing of a plurality of phone numbers included in a list stored by the communications device sequentially such that the dialing of at

least two of the plurality of phone numbers is initiated by a respective command, sequentially; and

- return to one or more of the plurality of phone numbers that are unanswered.

As stated above, Utsumi '816 discusses initiating a cleaning process, effective to clean an entire telephone list from a floppy disk, with *a single cleaning command that is not repeated*, but not “dialing of at least two of the plurality of phone numbers is *initiated by a respective command, sequentially*” as recited in claim 33. Therefore, it is respectfully submitted that Utsumi '816 adds nothing new to Utsumi '267, alone or in combination, which as admitted by the Examiner does not teach or suggest this feature. Withdrawal of the rejection is respectfully requested.

**Claims 34-43** depend either directly or indirectly from claim 33 and the comments directed above to claim 33 apply equally to claims 34-43. These claims also recite additional features which, in combination with those recited in claim 33, are neither shown nor suggested in the references of record, either singly or in combination with one another. Withdrawal of the rejection is respectfully requested.

**Claim 44** recites a communications device comprising a processor and memory having instructions that are executable on the processor to form a list having a plurality of telephone numbers of unanswered telephone calls of the communications device and provide a feature to sequentially initiate dialing of the

plurality of telephone numbers included in the list such that the dialing of at least two of the plurality of telephone numbers is initiated by a respective command, sequentially.

As described above, both Utsumi '816 and Utsumi '267 (alone and in combination) describe a system in which a single command is given to clean an entire list of telephone numbers and thus a plurality of telephone numbers are cleaned in response to a single command. However, as stated above Claim 44 (like claim 33) recites “the dialing of at least two of the plurality of phone numbers is *initiated by a respective command, sequentially*.” (emphasis added) Thus, the automated system of Utsumi '816 and '267 in which the entire list is “cleaned” in response to a single command differs from the features recited in these claims. Indeed, use of more than one command runs against the expressed purpose of automation of the asserted references and therefore a modification to either Utsumi reference would also be improper. Withdrawal of the rejection is respectfully requested.

**Claims 45-53** depend either directly or indirectly from claim 44 and the comments directed above to claim 44 apply equally to claims 45-53. These claims also recite additional features which, in combination with those recited in claim 44, are neither shown nor suggested in the references of record, either singly or in combination with one another. Withdrawal of the rejection is respectfully requested.

### **§103(a) Claim Rejections**

Claims 9-33, 34-36, and 45-47 are rejected under 35 U.S.C. §103(a) as being unpatentable by Utsumi '267. **Again, it is respectfully submitted that the Examiner meant to reject claims 9-11 instead of 9-33 as the rejection does not address claims 12-33.**

Regardless, in each instance the Examiner has again taken Official Notice that "it is well known in the art to use call commands in either abbreviated manual commands, manual or spoken entry methods." *See Office Action, Page 8.* The Applicant respectfully disagrees. As the Examiner is aware, "it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification." *In re Lulu*, 747 F.2d 703, 223 USPQ 1257, 1258 (Fed. Cir. 1984). In the present case, such a modification runs counter to the express purpose of automation of Utsumi as described above and therefore such a modification as proposed by the Examiner would not have been made. Withdrawal of the rejection is respectfully requested.

### **§103(a) Claim Rejections**

Claims 12, 13, 21-32, 37, 38, 48, and 49 are rejected under 35 U.S.C. §103(a) as being unpatentable by Utsumi '267 in view of U.S. Patent No. 5,636,267 to Iwase (hereinafter "Iwase"). The Applicant respectfully disagrees and reserves the right to challenge use of Iwase as a reference at a later date.

**Claim 12** recites “outputting a pre-recorded message associated with at least one of the first or second phone numbers **before dialing the at least one of the first or second phone numbers.**” (emphasis added). The Examiner, in rejecting this claim, correctly asserts that Utsumi ‘267 does not specifically teach these features. However, the Examiner then incorrectly applies Iwase to correct the defects of Utsumi.

For example, the Examiner asserts that the “Iwase reference however specifically teaches a device to communicate by telephone call and sending the destination phone number a prerecorded message. (Col. 1 line 48-55)” The Examiner also asserts that it “would have been obvious ... to implement a pre-recorded message to be sent to a destination number as taught by Iwase to the Utsumi reference in order *to communication* [sic] *to destination number users* to be informed for the reason of the phone call.” *See Office Action, Page 10.* Thus, following Iwase and the Examiner’s assertion, the telephone number is dialed *and then the prerecorded message is output.* However, as shown above claim 12 recites “*outputting a pre-recorded message ... before dialing* the at least one of the first or second telephone numbers.” Thus, Utsumi and Iwase do not support a § 103 rejection of claim 12. **Claim 13** depends from claim 12, so the comments directed to claim 12 apply equally to claim 13. In addition, claim 13 also recites features not shown or suggested by Utsumi and Iwase. Withdrawal of the rejection is respectfully requested.

**Claim 21** recites an apparatus comprising:

- means for receiving a command to dial at least one of a plurality of phone numbers included in a list;
- means for outputting a pre-recorded message that is associated with the one of the plurality of phone numbers;
- means for dialing the one of the plurality of phone numbers after the outputting of the pre-recorded message by the outputting means; and
- means for resolving a call to the one of the plurality of phone numbers that is a result of the dialing.

As previously described, neither Utsumi nor Iwase teach or suggest “means for dialing the one of the plurality of phone numbers ***after the outputting of the pre-recorded message*** by the outputting means,” alone or in combination. In the rejection, the Examiner makes the unsupported assertion that it “would have been obvious to one of ordinary skill in the art at the time of the invention to implement a pre-recorded message to be sent to a destination number as taught by Iwase to the Utsumi reference in order to communication [sic] to destination number users to be informed for the reason of the phone call.” *See Office Action, Page 11.* However, as shown in the above excerpt, ***the dialing is performed after the pre-recorded message is output***, and therefore ***is not output to a destination number*** nor can it be used to communicate to “destination number users to be informed for the reason of the phone call” as asserted by the Examiner. *See Office Action, Page 11.* Withdrawal of the rejection is respectfully requested.

In rejecting **claims 22-24**, the Examiner has taken Official Notice that “it is well known in the art to use call commands in either abbreviated manual commands, manual or spoken entry methods.” *See Office Action, Page 12*. The Applicant respectfully disagrees. As the Examiner is aware, “it is necessary to ascertain whether the prior art teachings would appear to be sufficient to one of ordinary skill in the art to suggest making the claimed substitution or other modification.” *In re Lahu*, 747 F.2d 703, 223 USPQ 1257, 1258 (Fed. Cir. 1984). In the present case, such a modification runs counter to the express purpose of Utsumi as described above (e.g., at Col. 8, Lines 16-42) and therefore such a modification as proposed by the Examiner is not proper. Iwase does not correct this defect, alone or in combination with the assertions. Withdrawal of the rejection is respectfully requested.

**Claims 25-32** depend either directly or indirectly from claim 21 and the comments directed above to claim 21 apply equally to claims 25-32. These claims also recite additional features which, in combination with those recited in claim 21, are neither shown nor suggested in the references of record, either singly or in combination with one another. Withdrawal of the rejection is respectfully requested.

Regarding **claims 37 and 48**, as discussed above the Examiner has asserted the combination of Utsumi ‘267 and Iwase as it “would have been obvious ... to implement a pre-recorded message to be sent to a destination number as taught by Iwase to the Utsumi reference in order to communication [sic] to destination



number users to be informed for the reason of the phone call.” See *Office Action*, Page 14. Withdrawal of the rejection is respectfully requested as this is clearly not the claimed feature. **Claim 38** depends from claim 37, so the comments directed to claim 37 apply equally to claim 38. In addition, claim 38 also recites features not shown or suggested by Utsumi and Iwase. **Claim 49** depends from claim 48, so the comments directed to claim 48 apply equally to claim 49. In addition, claim 49 also recites features not shown or suggested by Utsumi and Iwase. Withdrawal of the rejections is respectfully requested.

#### **New Claims**

**Claims 54-68** have been added. Applicant respectfully submits that the features of these claims are not disclosed, taught or suggested of the references either singly or in combination with one another disclose or suggest the subject matter of these claims. Support for the new claims may be found throughout the specification and drawings as filed.

**Claim 54**, for example, recites a method comprising:

- initiating dialing of a first phone number by a communications device responsive to a first command, the first phone number taken from a sequential list of phone numbers that includes at least the first phone number and a second phone number;

- deleting, by the communications device, the first phone number from the sequential list in response to completion of a call using the first phone number as a result of the dialing;
- after the completion of the call to the first phone number, initiating dialing of the second phone number taken from the sequential list responsive to a second command; and
- deleting, by the communications device, the second phone number from the sequential list in response to completion of a call using the second phone number.

Thus, in this claim dialing of the first phone number is initiated by a first command and the dialing of the second phone number is initiated by a second command. As described above, however, both of the alleged Utsumi references initiate dialing of a list in response to a single command. Accordingly, it is respectfully submitted that claims 54-68 overcome the asserted references of record.

**Conclusion**

The Applicant respectfully requests reconsideration and withdrawal of all rejections applied to the claims, and requests issuance of the present application. Should any issue remain that prevents immediate issuance of the application, the Examiner is requested to contact the undersigned attorney to discuss the unresolved issue.

Respectfully submitted,

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By: /William J. Breen, III/  
William J. Breen, III  
Reg. No. 45,313  
509.755.7253